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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/869,917

07/09/2001

Motohito Kanashima

2001-0971A

2734

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7590

06/22/2004

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

GRUN, JAMES LESLIE

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/869,917	Applicant(s) KANASHIMA ET AL.	
	Examiner James L Grun	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Technology Center 1600, Group 1640, Art Unit 1641.

The amendment filed 18 December 2003 is acknowledged and has been entered. Claims 5-10 are newly added. Claim 4 has been cancelled. Claims 1-3 and 5-10 remain in the case.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The disclosure is objected to because of the following informalities: the specification is replete with grammatical, idiomatic, and spelling errors too numerous to be specifically mentioned and should be carefully revised. Appropriate correction is required.

Claims 1-3 and 5-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-3, the interrelationships of the steps and components of the method are not clear. For example it is not clear how one measures PIVKA-II by merely adding thrombin and/or antibody binding to fibrin related substances to a sample.

In claims 1, 2, 5, 7, and 8, the recitation of "fibrin related substance" is vague and indefinite because it is entirely unclear how related to fibrin a substance needs to be for

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antibodies binding thereto to be encompassed within the metes and bounds of the subject matter for which applicant desires coverage because there is no standard for ascertaining the requisite degree of relatedness.

In claims 5-8, the interrelationships of the steps and components of the method are not clear. For example it is not clear for what the labeled antibodies are specific, how such antibodies relate to the other components, how PIVKA-II is measured, or to which reagent thrombin is added.

In claims 9 and 10, the interrelationships of the steps and components of the method are not clear. For example it is not clear for what the labeled antibodies are specific, how such antibodies relate to the other components, or how PIVKA-II is measured.

Applicant's arguments filed 18 December 2003 have been fully considered but they are not deemed to be persuasive. Applicant urges that the claims are definite when read in light of the specification. This is not found persuasive. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Method claims must be complete and clearly set forth the interrelationships of their steps and components. Moreover, a definition of a component in the specification which only provides representative examples of what is included does not clearly and definitely advise one of what else is included or what is excluded as being the component.

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Claims 1-3, 9, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsuda et al. (U.S. Pat. No. 4,780,410) in view of Lämmle et al. and Weir et al. for reasons of record in the prior rejection of the similar subject matter of claims 1-3.

Applicant's arguments filed 18 December 2003 have been fully considered but they are not deemed to be persuasive. Applicant urges that the specification shows surprising and unexpected results. This is not found persuasive for the reasons of record. Applicant urges that the prior art does not teach addition of antibodies specific for a fibrin related substance to a PIVKA-II immunoassay. This is not found persuasive because the argued limitation is either not found in the rejected claims or is recited in the alternative only in the rejected claims.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, ample motivation for the combination is found in the rejections of record.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

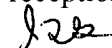
A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE **THREE MONTHS** FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN **TWO MONTHS** OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE **THREE-MONTH** SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN **SIX MONTHS** FROM THE MAILING DATE OF THIS FINAL ACTION.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Grun, Ph.D., whose telephone number is (571) 272-0821. The examiner can normally be reached on weekdays from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, SPE, can be contacted at (571) 272-0823.

The phone numbers for official facsimile transmitted communications to TC 1600, Group 1640, are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application, or requests to supply missing elements from Office communications, should be directed to the Group receptionist whose telephone number is (571) 272-1600.


James L. Grun, Ph.D.
June 16, 2004


CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800-1641